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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
DAYNA M. DECKER : EXAMINER: PRICE, CARL D.
SERIAL NO: 10/759,508 :
FILED: JANUARY 15, 2004 : GROUP ART UNIT: 3749
FOR: CANDLE HAVING A PLANAR :
WICK AND METHOD OF AND
EQUIPMENT FOR MAKING SAME

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Examiner's Answer dated August 6, 2009, please consider the following remarks.

A. Firewood References (Wood Species and Moisture Content)

The claims presently subject to appeal distinguish over the cited references, e.g., based on the attributes of the wicks included therein. It is undisputed that none of the cited references discloses a wick having attributes as recited in the present claims. The Examiner asserts, however, that it would have been obvious to modify the wooden wick in the candle of Ebeling to be made of cherry or poplar wood (e.g., claims 159 and 264) or to have a moisture content of 6 to 8 % (e.g., claims 179 and 264) in view of the teachings of Donnelly and Frisch – two references related to firewood.

As Appellant has argued previously, the teachings of Donnelly and Frisch that certain attributes of wood affect performance as firewood would not indicate to one of ordinary skill in the art that such attributes likewise affect performance as a wood wick. A wick does not simply burn in the manner of firewood. Instead, a wick conveys a combustible fuel – this is apparent, e.g., in view of the fact that a candle burns for a much longer time than a wick would be expected to burn if it did not form part of candle. The Examiner has repeatedly failed to explain why one of ordinary skill in the art would reasonably expect that the ability of a particular wood to yield particular effects when burned as firewood would translate into similar performance when conveying a combustible fuel as a wick. Appellant respectfully submits that one of ordinary skill in the art would reasonably expect such analogous performance.

Moreover, Appellant notes that the results set forth in the Declaration contradict the Examiner's position. For example, the Examiner appears to assert that a skilled artisan would select poplar because Donnelly indicates that poplar throws sparks when used as firewood. *See Examiner's Answer*, page 10. However, birch, which is listed along with poplar in the passage of Donnelly identified by the Examiner, is shown in the Declaration to have wholly different properties than poplar when used as a wick under like circumstances (i.e., birch makes a vastly inferior, non-functional wick). *See Declaration*, Tables K and N. These results further reaffirm that one of ordinary skill in the art would not reasonably expect that a wood's suitability as firewood would translate into suitability as a wood wick.

B. Wick Thickness

The Examiner asserts that selecting a wick thickness of from 0.023 to 0.028 inches (e.g., as in claims 199 and 264) is merely a matter of design choice. *See Examiner's Answer*, page 11. Appellant submits that modifying a parameter cannot be deemed a mere design

choice, if manipulating such parameter affects performance. *See, e.g.*, MPEP §2144.04. The Declaration clearly shows, e.g., that manipulating only the thickness of a wick affects the size of the flame produced by the wick and the ability of the wick to produce sound. *See* Declaration, Tables G and K. Selecting wick thickness is not a mere aesthetic design choice.

C. Experimental Results

The Examiner's Answer includes two critiques of the Declaration. First, the Examiner asserts that the Declaration does not demonstrate unexpected, superior results because the Declaration does not include "analysis or specific factual basis for the conclusions rendered." *See* Examiner's Answer, page 12. Second, the Examiner asserts that the unexpected, superior results in flame properties and crackling sounds are not commensurate in scope with the claims because the claims do not recite flame properties and crackling sounds. *See* Examiner's Answer, page 13.

With respect to the first critique, Appellant notes that the Declaration includes pages and pages of data. Only certain wick attributes provided a desirable result (good flame and crackling sound). Other wick attributes did not provide the desirable result. Appellant found the results to be unexpected. It is not clear what additional "interpretation" of the data would be required to satisfy the Examiner. The Declaration includes Appellant's data and Appellant's characterization of such data as unexpected. The Examiner has simply failed to provide a good faith basis for ignoring the experimental results and conclusions in the Declaration.

With respect to the second critique, the Examiner asserts that the results in the Declaration are not commensurate in scope with the claims because the claims do not explicitly recite the results. It is not necessary for a claim directed to an object to recite all

properties associated with such object – regardless of whether such properties are relied on to demonstrate patentability. There is simply no legal basis for the Examiner's position.

D. Attack on References Individually

In the Examiner's Answer, the Examiner repeatedly asserts that Appellant can not show non-obviousness by attacking references individually. *See* Examiner's Answer, pages 9 to 10. Appellant has not attacked the references individually, but rather has demonstrated that none of the references discloses a particular feature of the claims (i.e., a wick: formed of cherry or poplar, formed from a wood having substantially straight grains aligned, having a moisture content of from 6 to 8 percent and/or having a thickness of from 0.023 to 0.028 inches). *See, e.g.*, Appeal Brief, pages 5 to 7. Pointing out that no cited reference discloses a particular feature is not an attack on individual references, but rather an attack on the Examiner's alleged *prima facie* case of obviousness – for a combination of references to be said to disclose or suggest a combination of features, at least one of the references (or the general knowledge of a skilled artisan) must disclose or suggest each respective feature.

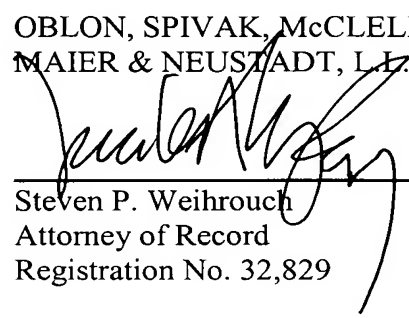
Moreover, Appellant has not merely argued that the cited references fail to disclose or suggest particular features of the claims, but rather has also explained why one of ordinary skill in the art would not have combined the references in a manner that could conceivably result in the respective claimed inventions. *See, e.g.*, Appeal Brief, pages 7 to 8. Instead of giving careful consideration and addressing Appellant's arguments for the patentability of the claims presently subject to appeal and the evidence submitted in support of such arguments, the Examiner has repeatedly relied on tenuous legal bases for ignoring the arguments and evidence altogether. Appellant respectfully requests that it's arguments and evidence be given due consideration.

E. Conclusion

In view of the foregoing remarks and the remarks set forth in the Appeal Brief filed April 23, 2009, reconsideration and reversal of the outstanding rejection are respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Steven P. Weihrouch
Attorney of Record
Registration No. 32,829

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)

Jacob A. Doughty
Registration No. 46,671